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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/219,890	12/24/1998	HIROSHI MORIKAWA	0557-4557-2	4189

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EXAMINER

LUU, SY D

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/219,890

Applicant(s)

MORIKAWA, HIROSHI

Examiner

Sy D Luu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 26-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 26-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is responsive to the Amendment D, filed 10/7/03.
2. Claims 11, 26-29 and 36-39 are pending in this application. Claims 1, 36-37, and 39 are independent claims. In the Amendment D, claims 30-35 were cancelled. This action is made Final.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 11, 26-29 and 36-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

All independent claims recite the limitation of "a multifunctional set/counter key...configured to vary initial set values and operating conditions in accordance with conditions of use", which is described in the specification in page 7, lines 7-9. Upon reconsideration of the disclosure, it is still not clear to the Examiner how the description of the set/counter key could be interpretable as "multifunctional". The function(s) of the set/counter key was not clearly defined

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as to what the "initial set values and operating conditions" are. Therefore, the Examiner will interpret the key as without "multifunctional".

Claim Rejections - 35 USC § 103

6. Claims 11, 26-29 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imada (US 5,880,851) in view of Hashimoto et al. ("Hashimoto", US 5,812,900), Ishikawa (US 4,448,515), Abe et al. ("Abe", US 6,353,482 B1), and Okamoto et al. ("Okamoto", US 5,602,625).

As per claim 11, Imada teaches an operation and display section of an operation unit for an image forming apparatus (fig. 3; col. 4, lines 30-37) comprising:

a touch screen panel substantially centered on the operation unit (*touch panel display 7*);

numeral keys (*numeric keypad 5*);

a clear/stop key (*key 51*);

a start key having a larger diameter than the numeral keys (*key 6*);

a set/counter key (*counter key 62 being used for setting the count or number of copies to be made*) configured to vary initial set values and operating conditions in accordance with conditions of use (*the counter key is used to set the initial values, such as number of copies, and the key could also be used later to modify the already set number of copies depending on conditions of use*); and

an interrupt key (*key 57*).

It is noted that Imada does not expressly refer to the counter key to be a set/counter key. However, as is known in the art the set key which is also known as counter key or set/counter

key in this context are generally used to refer to a same function which is to allow an user to set a desired number/count of copies to be made. For instance, Okamoto teaches an image forming apparatus, wherein a set key is used to set the count/number of copies (col. 20, line 40). It would have been obvious to an artisan at the time of the invention that Okamoto's set key and Imada's counter key are the same key functionally. Thus, Imada's key could be referred to as set/counter key so as to accommodate both references to the same functionality according to user's familiarities.

Although Imada teaches a preheat key (*key 56*), Imada does not explicitly indicate the preheat key to be a reset/preheat key. Furthermore Imada fails to teach: (a) an enter key, a program key, a set key, a trial copy key, a copy key, a copy server key, and a printer key; and (b) the positions of the keys relative to each other as claimed.

Per (a), Hashimoto teaches an image forming apparatus, wherein the operation panel includes an enter key, a program key, and a reset/preheat key (fig. 2; col. 5, lines 24-26; *keys 81, 80, and 76 respectively*). Ishikawa teaches an image forming system, wherein the operation panel includes a trial copy key (fig. 3; col. 5, lines 47-50; *trial copy switch 43*). Abe teaches an image forming system having operation mode selection keys for selecting one of Copy (*Copy*), Copy Server (*File*) and Printer (*Printer*) modes on the operation panel (fig. 3; col. 4, lines 48-52).

It would have been obvious to an artisan at the time of the invention to include these well known keys of Hashimoto, Ishikawa, Abe and Okamoto with Imada's operation unit in order to provide additional useful functionalities and capabilities to Imada's apparatus.

It is further noted that Abe's keys are presented as "soft" keys on the touch panel display rather than as mechanical keys as claimed. However, Official Notice is given that interchangeable use of "soft" and mechanical keys are well known in the art. Therefore, it would have been obvious to an artisan at the time of the invention to implement Abe's keys with Imada's operation unit using either method according to the choice of preference and implementation.

Per (b), although the keys on the operation unit of Imada, Hashimoto, Ishikawa, Okamoto and Abe are positioned in proximity of each other, they are not necessarily positioned in specific positions relative to each other as claimed. However, official notice is taken that function keys of an image forming apparatus being positioned in a number of different arrangements relative to each other is well known in the art. Thus, the specific location of where the keys are to be situated is not a factor in determining their functionalities, so long as the keys perform all required functionalities. It would have been obvious to an artisan at the time of the invention to position the keys in the specific arrangements as claimed according to the preference of design and implementation .

As per claims 26-29, Imada and the combined prior art do not disclose various keys such as the program key and trial copy key to be positioned according to the specific arrangements of the claimed limitations. However, official notice is taken that function keys of an image forming apparatus being positioned in a number of different arrangements relative to each other is well known in the art. Thus, the specific location of where the keys are to be situated is not a factor in determining their functionalities, so long as the keys perform all required functionalities. It

would have been obvious to an artisan at the time of the invention to position the keys in the specific arrangements as claimed according to the preference of design and implementation .

As per claims 36-39, all claim limitations are similar in scope to those that have been addressed in claims 11, and 26-29, and thus are rejected under similar rationale.

Response to Arguments

7. Applicant's arguments with respect to the newly amended feature regarding the set/counter key in the independent claims have been considered but they are not persuasive. See Examiner's response to the arguments regarding the set/counter key in the rejection section under 35 U.S.C. 112 for further detail.

Furthermore, as pointed out by the Examiner above, it is known in the art that the set key is also known as the counter key or set/counter key in this context, and the key would be generally used to refer to the same function which is to allow a user to set a desired number/count of copies to be made. See definitions of a set key by Nishimura (US 6,296,243 B1) at column 5, lines 18-19, and Okamoto et al. (US 5,602,625) at column 20, lines 40.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is **(703) 305-0409**. The examiner can normally be reached on Monday - Thursday from 7:00 am to 4:30 pm (EST). The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Sy Luu', with a long, sweeping horizontal line extending to the left and a checkmark-like flourish at the end.

SY D. LUU
PRIMARY EXAMINER